

REMARKS/ARGUMENTS

Claims 1, 4-6, 8-12 and 20-24 are pending. By this Amendment, claims 7, 19, and 25-27 are cancelled without prejudice or disclaimer and claims 8, 9, 20 and 22 are amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

By this Amendment, claims 8, 9, 20 and 22 have been rewritten in independent form, including all the limitations of the base claim and any intervening claims. For the reasons discussed in detail below, it is respectfully submitted that this Amendment places the application in condition for allowance. However, in the event that the instant application is not allowed, it is respectfully submitted that the Amendment must be entered as it places the claims in better form for appeal. See 37 C.F.R. §1.116(b)(2). Entry of the Amendment is respectfully requested.

Claims 7, 13, 19 and 25-27 were rejected under 35 U.S.C. §102(e) over Palkon et al. (U.S. Patent 7,007,696) and claims 8-12 and 20-24 were rejected under 35 U.S.C. §103(a) over Palkon et al. The rejections are respectfully traversed.

With respect to the features recited in claims 8, 9, 20 and 22, the March 4, 2008 Office Action acknowledges that Palkon et al. do not disclose or suggest these features, but concludes that the claims would have been obvious in view of Palkon et al. "since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art." The Office Action cites In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). See paragraphs 12-15, 17 and 18 of the March 4, 2008 Office Action.

In the responses filed July 9, 2007 and February 20, 2008, Applicants traversed the Examiner's reliance on the rationale used by the Court in In re Aller as the facts of In re Aller are

not sufficiently similar to the instant application to permit the Examiner to rely on the rationale used by the Court. See, for example, page 11 of the response filed February 20, 2008 and pages 13-15 of the July 9, 2007 response.

M.P.E.P. §2144.04 states:

if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

The facts of In re Aller are discussed in M.P.E.P. §2144.05(II).A. The case of In re Aller involved a claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70%. The claimed process was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.

M.P.E.P. §2144.05(II).B. discusses the case of In re Antoine, 559 F2d 618, 195 USPQ 6 (CCPA 1977). As the Court found in the case of In re Antoine, a particular parameter must be recognized by the prior art as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of the variable might be characterized as routine experimentation.

As was discussed on pages 14-15 of the response filed July 9, 2007, Palkon et al. do not disclose or suggest that any of the dimensions recited in claims 8, 9, 20 and 22 are result-effective variables. Palkon et al. disclose in column 4, lines 44-47, that the variable thicknesses in the membranes 46, 47 and 48 are a significant feature of the invention and provide a significant improvement in the comfort of the cushion 30. Palkon et al. also disclose in column 5, lines 24-29, that the length of the sidewall portion 45A provides an improved angle of contact when the cushion 30A is worn by the user. Therefore, the only result-effective variables

recognized by Palkon et al. are the variable thicknesses of the membranes and the length of the sidewall portions of the cushion. Palkon et al. do not recognize that a width of the membrane orifice or the membrane height is a result-effective variable. Accordingly, it would not have been obvious to one of ordinary skill in the art to modify Palkon et al. to arrive at the dimensions recited in claim 8.

Moreover, claim 9 recites the dimensions of the rim aperture and an effective height of the rim, and an effective ridge depth of the rim. Palkon et al. do not recognize that any of these features are a result-effective variable. Therefore, claim 9 would not have been obvious to one of ordinary skill in the art.

In response to Applicants' arguments filed July 9, 2007 and February 20, 2008, the March 4, 2008 Office Action states on page 2, paragraph 2, the dimensions described in claims 8-12 and 20-24 depend on the size babies, kids and adults. The Office Action further concludes that because not all babies, kids or adults have the same size, it would have been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or workable ranges involves only routine skill in the art since the size of the device depends on the size of the baby, kid or adult.

It is respectfully submitted that Palkon et al. do not disclose or suggest any age range or size range of the mask cushion, other than the variable thicknesses of the membranes and the dimensions of the sidewall in the nasal bridge region and the lip region, as discussed above. Accordingly, Palkon et al. do not disclose or suggest the general conditions of claims 8, 9, 20 and 24.

Moreover, as disclosed, for example, in paragraph [0014], of the instant application, the process of scaling down an adult size mask to approximate the face and nose of an infant are

three-fold. In other words, the process of designing a mask, including a cushion, to fit the face of a neonatal baby or infant involves more than the process of changing the scale of an adult mask. The dimensions recited in claims 8, 9, 20 and 24 are therefore not the result of routine experimentation and optimization.

Claims 10-12, 21, 23 and 24 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claims 8, 9, 20 and 22 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) over Palkon et al. are respectfully requested.

In view of the above amendments and remarks, applicants respectfully submit that all of the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is necessary to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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